SUPREME COURT OF THE UNITED STATES.

No. 160.

CHARLES J. GAYLER AND LEONARD BROWN, PLAINTIFFS IN ERROR,

vs.

BENJAMIN G. WILDER.

IN ERROR TO THE CIRCUIT COURT OF U. S. FOR NEW YORK.

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J. & G. S. Gideon, printers.

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America, to the judges of the circuit court of the United States, for the southern district of New York, greeting:

Because, in the record and proceedings, as also in the rendition of the judgment of a plea, which is in the said circuit court, before you, or some of you, between Benjamin G. Wilder, plaintiff, and Charles J. Gayler and Leonard Brown, defendants, a manifest error hath happened to the great damage of the said Charles J. Gayler and Leonard Brown, as is said, and as appears by their complaint; we, being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the justices of the Supreme Court of the United States, at the Capitol, in the city of Washington, together with this writ, so that you have the same at the said place, before the justices aforesaid, on the sixth day of December next, that the record and proceedings aforesaid being inspected, the said justices of the Supreme Court may cause further to be done therein to correct that error, what of right and according to the law and custom of the United States ought to be done.

Witness the honorable Roger B. Taney, chief justice of the Supreme Court of the United States, this eighteenth day of November, in the year of our Lord one thousand eight hundred and forty-seven, and of the independence of the United States the seventy-second.

ALEX'R GARDINER,
Clerk of the circuit court of the United States of America, for the southern district of New York, in the second circuit.

The answer of the judges of the circuit court of the United States, for the southern district of New York, in the second circuit, in the within writ mentioned.

The record and proceedings, whereof mention is within made, together with all things concerning the same, are hereby respectfully certified to the justices of the Supreme Court of the United States within mentioned, in a certain schedule to this writ attached, as within it is commanded.

Witness the honorable Roger B. Taney, chief justice of the Supreme Court of the United States, this sixth day of December, in the year of our Lord one thousand eight hundred and forty-seven, and of the independence of the United States the seventy-second.

ALEX'R GARDINER,
Clerk of the U. S. circuit court for the So. Dist. of New York.

By the honorable Samuel Nelson, one of the judges of the circuit court of the United States, for the southern district of New York, in the second circuit, to Benjamin G. Wilder.

Whereas, Charles J. Gayler and Leonard Brown lately issued out of the Supreme Court of the United States a writ of error, directed to the judge of the circuit court of the United States, for the southern district of New York, stating that, in the record and proceedings, as also in the rendition of the judgment of a plea in the said court, before the judge thereof, between you, Benjamin G. Wilder, as plaintiff, and Charles J. Gayler and Leonard Brown, as defendants, a manifest error hath happened to the great damage of the said Charles J. Gayler and Leonard Brown; and whereas, for the correction of that error in due manner, the said writ has been issued, returnable at the next stated Supreme Court of the United States, at the city of Washington, on the sixth day of December next, you are, therefore, hereby cited to appear before the said Supreme Court, at the city of Washington, on the said sixth day of December next, to do and receive what may appertain to justice to be done in the premises.

Given under my hand, at the city of New York, in the southern district of New York, in the second circuit, the twenty-fifth day of November, in the year of our Lord one thousand eight hundred and forty-seven, and of the independence of the United States the seventy-second.

S. NELSON.

Filed December 6, 1847.

I hereby depute Joseph Thompson to execute the within process.
Dated 4th December, 1847.

ELY MOORE,
U. S. Marshal.

Personally served a copy of the within citation on the within named Benjamin G. Wilder, and at the same [time] showed him the original.

ELY MOORE,
U. S. Marshal.

December 4th, 1847.

UNITED STATES OF AMERICA,
Southern district of New York, ss:

I, Alexander Gardiner, clerk of the circuit court of the United States of America, for the southern district of New York, in the second circuit, do hereby certify, that the writings annexed to this certificate are true copies of their respective originals on file and remaining of record in my office.

[SEAL.]

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the city of New York, in the southern district of New York, in the second circuit, this sixth day of December, in the year of our Lord one thousand eight hundred and forty-seven, and of the independence of the said United States the seventy-second.

ALEX'R GARDINER, *Clerk.*

Pleas in the circuit court of the United States for the southern district of New York, in the second circuit, before the judges thereof, at the City Hall in the city of New York, of November term, in the year of our Lord eighteen hundred and forty-five.

Witness:

SAMUEL NELSON, esq.,
U. S. circuit judge.
ALEXANDER GARDINER,
Clerk circuit court United States for southern district of New York.

SOUTHERN DISTRICT OF NEW YORK, *ss:*

Be it remembered, that heretofore, to wit, on the twelfth day of February, in the year of our Lord one thousand eight hundred and forty-six, being as yet of November term of the year 1845, before the judges of the circuit court of the United States for the southern district of New York, in the second circuit, came Benjamin G. Wilder, by John B. Staples, his attorney, at the City Hall in the city of New York, and brought into the said court, before the aforesaid judges thereof, his certain bill against Charles J. Gayler and Leonard Brown, being in custody, &c., of a plea of trespass on the case for the violation and infringement of a patent right belonging to the plaintiff, which said bill is in the words and figures following, to wit:

Circuit court of the United States for the southern district of New York.
Of the twelfth day of February, eighteen hundred and forty-six.

SOUTHERN DISTRICT OF NEW YORK, *ss:*

Benjamin G. Wilder, plaintiff in this suit, by John B. Staples, his attorney, complains of Charles J. Gayler and Leonard Brown, defendants, in custody, &c., of a plea of trespass on the case, &c.

For that whereas, heretofore, Daniel Fitzgerald was the original and first inventor of a new and useful improvement in fire-proof chests or safes, in the letters patent hereinafter mentioned and fully described, and which had not been, at the time of his application for a patent, in public use, or on sale, with his consent or allowance, in the United States or elsewhere.

And thereupon such proceedings were had, that heretofore, to wit, on the first day of June, eighteen hundred and forty-three, upon the application therefor by the said Daniel Fitzgerald, letters patent in due form of law were issued to the said Daniel Fitzgerald, for the said new and useful improvement, under the seal of the Patent office of the United States, signed by the Secretary of State, and countersigned by the Commissioner of Patents, bearing date the day and year last aforesaid, whereby there was granted and secured to the said Daniel Fitzgerald, and to his heirs, administrators, and assigns, for the term of fourteen years, from the first day of June, eighteen hundred and forty-three, the full and exclusive right of making, constructing, using, and vend-

ing to others to be used, the said improvement, a description whereof is given in the words of the said Daniel Fitzgerald in the schedule to the said letters patent annexed and making part thereof; which said patent and specification are in language, of the import, and to the effect following, to wit:

THE UNITED STATES OF AMERICA:

To all to whom these letters patent shall come:

Whereas Daniel Fitzgerald, [of] New York, has alleged that he has invented a new and useful improvement in fire-proof chests and safes, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are therefore to grant, according to law, to the said Daniel Fitzgerald, his heirs, administrators, or assigns, for the term of fourteen years, from the first day of June, one thousand eight hundred and forty-three, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Daniel Fitzgerald, in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent office has been hereunto affixed.

[L. S.] Given under my hand, at the city of Washington, this first day of June, in the year of our Lord one thousand eight hundred and forty-three, and of the independence of the United States of America the sixty-seventh.

H. S. LEGARE,
Secretary of State.

Countersigned and sealed with the seal of the Patent office.

J. W. HAND,
Act'g Commissioner of Patents.

The schedule referred to in these letters patent, and making part of the same.

To all whom it may concern:

Be it known that I, Daniel Fitzgerald, of the city, county, and State of New York, and a citizen of the United States, have discovered and made an improvement, new and useful, in the construction of iron chests or safes, intended to resist the action of fire, and for the safe

keeping and preserving books and papers, and other valuables, from destruction by fire, which I call a Salamander safe or chest.

The following is a full and exact description of the safe or chest, with my improvement combined therewith:

I make two iron chests, in the common and ordinary way of making iron chests, which is well known to those engaged in this branch of business, one smaller than the other, which, when the safe is put together, forms the inner chest, or inner part of the safe. The other chest is made about three inches larger than the inner one, and so as, when put together, it will form the outer part or crust of the safe, and leave a space between the inner and outer chests of the safe of about three inches; which space may vary a little, more or less, when the chests are put together, but should be the same all round, and in every direction. The inner and outer doors, where two doors are used, are prepared in the same way, leaving a space, as above, between the inner and outer crust of each door, which space is left for a like purpose with that left between the inner and outer chest of the safe. Where one door is used, it should be made in the same manner, leaving a like space between the inner and outer crust or face of the door, and for a like purpose, and should be fitted to the chest or safe with great accuracy. The edges and openings for the doors are to be neatly finished, as in other chests. I then take plaster of paris or gypsum, and having boiled it or baked it in an oven, and calcined it, and reduced it to a powder, I mix it with water till it is about the consistency of cream or thin paste, so fluid as that it may readily be poured into the space left as above to receive it, and I then fill all the space with the plaster of paris, putting in some sheets of mica between the inner and outer chest, to aid, if necessary, in checking the progress of the heat.

But where pains are taken to have all the space left for the purpose properly filled with the plaster of paris, as above, so that when set it will expand and adhere firmly to the surrounding parts, and completely fill the whole space, and all the cracks and joints, the mica may be dispensed with, and every other substance, and the plaster may be used alone. It may also be reduced to a powder, without being prepared as above, and used in that state, but I have not found it as good.

The inner case or chest may be made of wood instead of iron, as for a bookcase, and the space left between that and the outer chest filled in the manner, and with the materials above named, will make a very durable safe, that will effectually resist the fire, as I have found by experience; but the safe may not be so strong or durable, though somewhat cheaper.

The above composition or preparation of gypsum may be mixed with several other articles not contrary to its nature, with a view to increase its efficacy in resisting the action of fire; but from my experience I doubt if they have much effect. The gypsum alone, when properly prepared, and properly placed in the space left to receive it, and made to fill it completely, is quite sufficient to resist, for a long space of time, the most intense heat. The chemical properties of this article are such,

that by the application of intense heat it imparts a vapor, or gas, or some other properties, which effectually stay the progress of the fire and arrest the influence and effects of the heat; this I have ascertained by various experiments; and I believe I am the first man that discovered the utility, and devised the method of applying gypsum or the plaster of paris to increase the safety of an iron chest. I am not aware that this article was ever used for the purposes above set forth, until I used it in manner above described.

I therefore claim, as my discovery, and invention, and improvement, the application and use of plaster of paris or gypsum in its raw state, or prepared as above, either alone or with mica, in the construction of all iron chests or safes, in the manner above described, or in any other manner substantially the same.

DANIEL FITZGERALD.

Witnesses:
G. H. PATTERSON,
BEVERLEY R. HENSON, jr.

As by the said letters patent and specification, all in due form of law, ready in court to be produced, will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that the said Daniel Fitzgerald, before the date of the said letters patent, and before the committing of the several grievances hereinafter mentioned and set forth, to wit, on the seventh day of April, in the year of our Lord one thousand eight hundred and thirty-nine, at the city of New York, and within the southern district of New York aforesaid, by a certain conveyance or assignment then and there made by the said Daniel Fitzgerald—which said conveyance or assignment, sealed with the seal of the said Daniel Fitzgerald, he, the said plaintiff, now brings here into court, the date whereof is the day and year last aforesaid—did assign, transfer, and set over, unto Enos Wilder, in his lifetime, all the right, title, and interest of him, the said Daniel Fitzgerald, in the invention therein mentioned, and in the letters patent which might be granted therefor, and the full and exclusive right, title, and interest, to all the improvements made by the said Daniel Fitzgerald; which said assignment and conveyance are in language of the import and to the effect following, to wit:

Whereas I, Daniel Fitzgerald, of the city, county, and State of New York, have invented certain improvements in safes, which invention I call the "Salamander safe," for which I am about to make application for letters patent of the United States. And whereas E. Wilder, of New York aforesaid, has agreed to purchase from me all right, and title, and interest, which I have, or may have, in and to the said invention, in consequence of the grant of letters patent therefor, and has paid to me, the said Fitzgerald, the sum of five thousand dollars, the receipt whereof is hereby acknowledged.

Now, this indenture witnesseth, that, for and in consideration of the said sum to me paid, I have assigned and transferred to E. Wilder

aforesaid the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor. And I hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder and his legal representatives.

In testimony whereof I have hereunto set my hand, and affixed my seal, this eleventh day of April, 1839.

DANIEL FITZGERALD. [SEAL.]

Witnesses: OWEN G. WARREN,
CHARLES H. FOSTER.

And the said plaintiff further saith, that the said assignment was duly recorded in the Patent office of the United States on the first day of June, eighteen hundred and thirty-nine, in liber C, page 527, of transfers of patent rights, as by the certificate of record thereof will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that the invention, and improvement, and letters patent, above mentioned, are the same invention, improvement, and letters patent mentioned in the assignment aforesaid.

And the said plaintiff further saith, that the said Enos Wilder, in his lifetime, always, from the date of the letters patent aforesaid until the time next hereinafter mentioned, by himself, his servants, deputies, and agents, made, manufactured, used, and vended to others to be used, the said improvement, to the great profit and advantage of him, the said Enos Wilder, to wit, within the southern district of New York aforesaid.

And the said plaintiff further saith, that the said Enos Wilder, in his lifetime, after the making of the said assignment by the said Daniel Fitzgerald to the said Enos Wilder, as aforementioned, and before the committing of the several grievances hereinafter mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and within the southern district of New York aforesaid, did execute a certain instrument or agreement to the said plaintiff, whereby the said Enos Wilder, in consideration of the agreement made with the said plaintiff, and of one dollar, to him, the said Enos Wilder, in hand paid by the said plaintiff, bargained, sold, conveyed, and assigned to the said plaintiff, all the right, title, and interest of him, the said Enos Wilder, in and unto the patent granted to the said Daniel Fitzgerald for an improvement in fire-proof safes and chests, by the use of prepared gypsum, dated June *June* 1, 1843; and of which patent he, the said Enos Wilder, was the sole owner and assignee, as will appear by the records of the Patent office; and which patent he, the said Enos Wilder, had good right to sell and convey to the said plaintiff, to be by him, the said plaintiff, held as his own property, free from all claims from the said Enos Wilder, or any one claiming under him, the said Enos Wilder, as by the said instrument or agreement, sealed with the seal of the said Enos Wilder, ready in court to be produced, will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that the said last mentioned instrument or agreement was duly recorded, liber N, page 287, of transfers of patent rights, in the Patent office of the United States, on the tenth day of October, 1843, as by the certificate of record thereof, ready in court to be produced, will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that, by virtue of the said last mentioned instrument or agreement, the said plaintiff became, and ever since hath been, interested in, and the sole owner of, the said improvement, and of the said right secured in and by the said letters patent.

And the said plaintiff further saith, that the said plaintiff has always, from the time of the making the said last mentioned instrument or agreement as aforesaid, by himself, his deputies, servants, and agents, in that behalf, made, manufactured, used, and vended to others to be used, the said improvement, to his great advantage and profit, to wit, within the southern district of New York aforesaid.

Yet the said defendants, well knowing the premises, but contriving, and wrongfully and injuriously intending to injure the said plaintiff, and to deprive him of the profits, benefits, and advantages which he might, and otherwise would, have derived and acquired from the making, manufacturing, using, and vending to others to be used, the said improvement, after the making of the said letters patent and of the said last mentioned instrument or agreement, and within the term of years in the said letters patent mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and on divers other days between that day and the day of the commencement of this suit, to wit, within the southern district of New York aforesaid, unlawfully and unjustly, and without the leave or license, and against the will of the said plaintiff, made and manufactured, and sold, divers, to wit, five hundred iron safes or chests, in the manner and of the materials described in the said letters patent, and of the exclusive right secured thereby, and contrary to the statutes of the United States in such case made and provided.

And the said plaintiff further says, that the said letters patent having been so made and issued as aforesaid; and the said plaintiff, by virtue of the making of the said last mentioned instrument or agreement, having become the sole owner of the said improvement; and the said plaintiff having, by himself, his deputies, servants, and agents in that behalf, caused to be made and manufactured, and having put on sale and offered for sale at fair and reasonable prices, on each and every day from the time of the making the said last mentioned instrument or agreement up to the day of the commencement of this suit, iron chests or safes made in the manner and of the materials described in the said letters patent and specifications thereto annexed, and making part of the same as aforesaid, to wit, within the southern district of New York aforesaid, to the great benefit and advantage of the said plaintiff.

Yet the said defendants, well knowing the premises, but further con-

aforesaid the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor. And I hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder and his legal representatives.

In testimony whereof I have hereunto set my hand, and affixed my seal, this eleventh day of April, 1839.

DANIEL FITZGERALD. [SEAL.]

Witnesses: OWEN G. WARREN,
CHARLES H. FOSTER.

And the said plaintiff further saith, that the said assignment was duly recorded in the Patent office of the United States on the first day of June, eighteen hundred and thirty-nine, in liber C, page 527, of transfers of patent rights, as by the certificate of record thereof will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that the invention, and improvement, and letters patent, above mentioned, are the same invention, improvement, and letters patent mentioned in the assignment aforesaid.

And the said plaintiff further saith, that the said Enos Wilder, in his lifetime, always, from the date of the letters patent aforesaid until the time next hereinafter mentioned, by himself, his servants, deputies, and agents, made, manufactured, used, and vended to others to be used, the said improvement, to the great profit and advantage of him, the said Enos Wilder, to wit, within the southern district of New York aforesaid.

And the said plaintiff further saith, that the said Enos Wilder, in his lifetime, after the making of the said assignment by the said Daniel Fitzgerald to the said Enos Wilder, as aforementioned, and before the committing of the several grievances hereinafter mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and within the southern district of New York aforesaid, did execute a certain instrument or agreement to the said plaintiff, whereby the said Enos Wilder, in consideration of the agreement made with the said plaintiff, and of one dollar, to him, the said Enos Wilder, in hand paid by the said plaintiff, bargained, sold, conveyed, and assigned to the said plaintiff, all the right, title, and interest of him, the said Enos Wilder, in and unto the patent granted to the said Daniel Fitzgerald for an improvement in fire-proof safes and chests, by the use of prepared gypsum, dated June *June* 1, 1843; and of which patent he, the said Enos Wilder, was the sole owner and assignee, as will appear by the records of the Patent office; and which patent he, the said Enos Wilder, had good right to sell and convey to the said plaintiff, to be by him, the said plaintiff, held as his own property, free from all claims from the said Enos Wilder, or any one claiming under him, the said Enos Wilder, as by the said instrument or agreement, sealed with the seal of the said Enos Wilder, ready in court to be produced, will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that the said last mentioned instrument or agreement was duly recorded, liber N, page 287, of transfers of patent rights, in the Patent office of the United States, on the tenth day of October, 1843, as by the certificate of record thereof, ready in court to be produced, will, reference thereunto being had, fully and at large appear.

And the said plaintiff further saith, that, by virtue of the said last mentioned instrument or agreement, the said plaintiff became, and ever since hath been, interested in, and the sole owner of, the said improvement, and of the said right secured in and by the said letters patent.

And the said plaintiff further saith, that the said plaintiff has always, from the time of the making the said last mentioned instrument or agreement as aforesaid, by himself, his deputies, servants, and agents, in that behalf, made, manufactured, used, and vended to others to be used, the said improvement, to his great advantage and profit, to wit, within the southern district of New York aforesaid.

Yet the said defendants, well knowing the premises, but contriving, and wrongfully and injuriously intending to injure the said plaintiff, and to deprive him of the profits, benefits, and advantages which he might, and otherwise would, have derived and acquired from the making, manufacturing, using, and vending to others to be used, the said improvement, after the making of the said letters patent and of the said last mentioned instrument or agreement, and within the term of years in the said letters patent mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and on divers other days between that day and the day of the commencement of this suit, to wit, within the southern district of New York aforesaid, unlawfully and unjustly, and without the leave or license, and against the will of the said plaintiff, made and manufactured, and sold, divers, to wit, five hundred iron safes or chests, in the manner and of the materials described in the said letters patent, and of the exclusive right secured thereby, and contrary to the statutes of the United States in such case made and provided.

And the said plaintiff further says, that the said letters patent having been so made and issued as aforesaid; and the said plaintiff, by virtue of the making of the said last mentioned instrument or agreement, having become the sole owner of the said improvement; and the said plaintiff having, by himself, his deputies, servants, and agents in that behalf, caused to be made and manufactured, and having put on sale and offered for sale at fair and reasonable prices, on each and every day from the time of the making the said last mentioned instrument or agreement up to the day of the commencement of this suit, iron chests or safes made in the manner and of the materials described in the said letters patent and specifications thereto annexed, and making part of the same as aforesaid, to wit, within the southern district of New York aforesaid, to the great benefit and advantage of the said plaintiff.

Yet the said defendants, well knowing the premises, but further con-

triving and intending as aforesaid, after the making of the said last mentioned instrument or agreement as aforesaid, and within the term of years in the said letters patent mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and on divers other days between that day and the day of the commencement of this suit, to wit, within the southern district of New York aforesaid, unlawfully and unjustly, and without the leave or license, and against the will of the said plaintiff, made and manufactured and sold, and caused to be made, manufactured, and sold, divers, to wit, five hundred iron safes or chests, in the manner and of the materials described in the said letters patent, and in imitation thereof, and violation of the said letters patent, and against the exclusive right so secured by the said letters patent, and contrary to the statutes of the United States in such case made and provided.

And the said plaintiff further saith, that the said letters patent having been so made and issued as aforesaid, and the said plaintiff, by virtue of the making of the said last mentioned instrument or assignment, having become the sole owner of the said improvement, and the said plaintiff having, by himself, his deputies, servants, and agents in that behalf, caused to be made and manufactured, and having put on sale, and offered for sale, at fair and reasonable prices, on each and every day from the time of the making the said last mentioned instrument or agreement, up to the day of the commencement of this suit, iron chests or safes, made in the manner and of the materials described in the said letters patent and specification thereto annexed, and making part of the same as aforesaid, to wit, within the southern district of New York aforesaid, to the great profit, benefit, and advantage of the said plaintiff.

Yet the said defendants, well knowing the premises, but further contriving and intending as aforesaid, after the making of the said last mentioned instrument or agreement as aforesaid, and within the term of years in the said letters patent mentioned, to wit, on the first day of September, in the year of our Lord one thousand eight hundred and forty-three, and on divers other days between that day and the day of the commencement of this suit, to wit, within the southern district of New York aforesaid, unlawfully and unjustly, and without the leave or license, and against the will of the said plaintiff, put on sale, and offered for sale, and sold divers, to wit, five hundred iron safes or chests, made in the manner and of the materials described in the said letters patent, and in imitation thereof, in infringement and violation of the said letters patent, and against the exclusive right so secured by the said letters patent, and contrary to the statutes of the United States in such case made and provided.

By means of all which the said plaintiff has been greatly injured and deprived of great profits, benefits, and advantages, which he might and otherwise would have derived and acquired from said improvement, and has sustained actual damages to the amount of five thousand dollars; and, by force of the statutes aforesaid, an action hath accrued

to the said plaintiff to recover of the said defendants the said actual damages, and such additional amount, not exceeding in the whole three times the amount of said actual damages, as the court may see fit to order and adjudge.

Yet the said defendants, though often requested, hath never paid the same, nor any part thereof, to the said plaintiff, but hath hitherto wholly refused and still doth refuse; and therefore the said plaintiff brings suit.

JOHN DOE & RICHARD ROE,
Pledges to prosecute, &c.

SOUTHERN DISTRICT OF NEW YORK, *ss:*

Benjamin G. Wilder, plaintiff in this suit, puts in his place John B. Staples, his attorney, against Charles J. Gayler and Leonard Brown, defendants, in the plea aforesaid.

And the said defendants, Charles J. Gayler and Leonard Brown, by John W. C. Leveridge their attorney, come and defend the wrong and injury, when, &c., and say that they are not guilty of the said supposed grievances above laid to their charge, in manner and form as the said Benjamin G. Wilder, plaintiff, hath above thereof complained against them; and of this they, the said defendants, put themselves upon the country, and the said plaintiff doth the like, &c.

And the said defendants accompanied their said plea by a notice, pursuant to the statute in such case made and provided, of which the following is a copy:

SIR: You will please to take notice that, under the several issues above pleaded, the defendants, Charles J. Gayler and Leonard Brown, will insist upon and give in evidence, upon the trial of the above entitled cause, according to the form of the act of Congress of the United States of America in such case made and provided, that Daniel Fitzgerald, in the declaration of the said plaintiff named, was not the sole, the original, and the first inventor or discoverer of the improvement or thing patented, for which a patent was obtained, as in said declaration of the said paintiff set forth, and that the same was not a new and useful improvement.

That, on or about the eighth day of May, in the year one thousand eight hundred and thirty-seven, a patent was granted by the United States of America unto one Benjamin Sherwood, for an improvement in the mode of making fire proof chests, in which gypsum or plaster of paris was used and applied for the same purpose as that of the said Daniel Fitzgerald, the patentee in the said declaration mentioned; and in which invention of the said Benjamin Sherwood, the alleged invention and improvement of the said Daniel Fitzgerald forms a material and substantial part, and by reason whereof the application of the said Daniel Fitzgerald, for a patent, was from time to time, and on several occasions, refused by the Commissioner of Patents.

And the said defendants, Charles J. Gayler and Leonard Brown, will further insist upon, and give in evidence upon the trial of the cause as aforesaid, that the specifications or written descriptions annexed to the

alleged letters patent of the said Daniel Fitzgerald, and set forth in the declaration of the said plaintiff in this cause, does not contain the whole truth relative to the said pretended invention or discovery of the said Daniel Fitzgerald; and that the same description or specifications are so vaguely or obscurely drawn as not to instruct or shew the manner of the application of the gypsum or plaster of paris, or mica, in the construction or filling in the space between the inner and outer chests in the safe, as is alleged to have been patented by the said Daniel Fitzgerald, without other instructions than those in said specifications or description contained; and that one William Marr, of the city of London, in that part of the United Kingdom of Great Britain and Ireland called England, invented and discovered, or used or applied, or knew the same thing in London aforesaid, on or about the year one thousand eight hundred and thirty-four, or some time prior to the pretended discovery of the said Daniel Fitzgerald, and for which invention of the said William Marr, the said pretended discovery of the said Daniel Fitzgerald forms a material and substantial part, he, the said William Marr, in or about the month of February, one thousand eight hundred and thirty-four, obtained letters patent for, and which said invention and discovery of the said William Marr, and for which letters patent were granted to him as aforesaid, was noticed or published in a printed publication or work known as the Repertory of Patent Inventions, published in England in the year 1834, and also in a printed publication or work known as the London Journal of Arts and Sciences, vol. 4, for 1834, page 103, published in England.

And the said defendants, Charles J. Gayler and Leonard Brown, will further insist upon, and give in evidence upon the trial of this cause as aforesaid, that before the application for the said patent mentioned in the said declaration in this cause the pretended invention or improvement of the said Daniel Fitzgerald, for which said patent was granted, was abandoned to the public, and had been in public use and on sale with the consent and allowance of the said Daniel Fitzgerald, and also of Enos Wilder, to whom he assigned the same, and also for the said plaintiff in this cause, for more than two years prior to such application, in the following places in the State of New York, to wit, in the city of New York, in the city of Brooklyn, in the city of Albany, in the city of Utica, in the city of Rochester, and in the city of Buffalo. Also in the following places in the State of Massachusetts, to wit, in the city of Boston, in Chelsea. Also in the following places in the State of Pennsylvania, to wit, in the city of Pittsburg, and in the city of Philadelphia. Also in Cincinnati, in the State of Ohio. Also in Baltimore, in the State of Maryland. Also in Wilmington, in the State of Delaware. Also in Richmond, in the State of Virginia. Also in Charleston, in the State of South Carolina. Also in Savannah, in the State of Georgia. Also in New Orleans, in the State of Louisiana. And also in divers other places in the United States of America.

And further, that fire-proof safes or chests, in which gypsum or plaster of paris alone, or combined with other indestructible substances or

material, or non-conductor of heat, was used and applied, were in the year one thousand eight hundred and thirty-four, manufactured in London, in that part of the United Kingdom of Great Britain and Ireland called England. Also that fire-proof safes or chests, in which gypsum or plaster of paris alone, or combined with mica, clay, and indestructible substances or material, or non-conductor of heat, and fire-proof safes or chests filled with other known non conducting material, or the indestructible substance or non-conductor of heat, and which was used and applied in their manufactures, were manufactured in the city of New York by the defendant, Charles J. Gayler, and as one of the firm of J. L. Brown & Co., long prior to the application of, and the granting of, the said patent to the said Daniel Fitzgerald. Also by Nathaniel Hodgson, Thomas S. Rhodes, John Bruce, Jesse Delano, Andrew Latimer, James Salman, and William Delano, in the city of New York, prior to and in the years 1835 and 1836; and by Constable and Stickler, Attwood, Jones & Co , and Jones, Attwood & Co., in Pittsburgh aforesaid; and by one John Scott in the city of Philadelphia aforesaid, from 1834 to the present time. Also by one George W. Cross, and by the said John Scott and George W. Cross, in the said cities of Philadelphia and Pittsburgh from 1836 to about the year 1839, and from that time by both of them, to the present time, to wit, by the said George W. Cross in the said city of Philadelphia, and by the said John Scott in the city of Baltimore aforesaid, and were so made and on sale in the said cities of London, Philadelphia, Pittsburgh, Cincinnati, Baltimore, Wilmington, Richmond, Charleston, Savannah, New Orleans, Boston, Chelsea, New York, Brooklyn, Albany, Utica, Rochester, and Buffalo, and in divers other places in the United States, long prior to the pretended discovery and alleged patent of the said Daniel Fitzgerald.

And the said defendants, Charles J. Gayler and Leonard Brown, will further insist upon, and give in evidence upon the trial of this cause as aforesaid, that the said Daniel Fitzgerald was not the sole, the original, and the first inventor or discoverer of a substantial and material part of the improvement, or thing patented, for which a patent was obtained, as is in said declaration of the said plaintiff set forth. That the said patent, so as aforesaid granted to the said Daniel Fitzgerald, as is in the said declaration of the said plaintiff set forth, was surreptitiously or unjustly obtained by the said Daniel Fitzgerald; and that the said Enos Wilder and the plaintiff in this cause well knew the fact that the said patent was so surreptitiously or unjustly obtained. That the use of gypsum or plaster of paris as an indestructible substance or material, or non-conductor of heat, and also mica, and that they, either separate or united, would remit the action of fire and heat, [has] been known, used, and applied, separate and together, in the manufacture of fire-proof safes or chests, and for other purposes, in Europe and in the United States of America, for a long period of time prior to and since the application of, and in the granting of, the said patent to the said Daniel Fitzgerald; and the same were described in the following printed publications, or works, long prior to and since the application

of, and also of the granting of, the said patent to the said Daniel Fitzgerald, that is to say: "Jeremiah Franklin Institute," Philadelphia, from 1826 to 1830; also volumes 16 and 22, and volume 1, 1828, of the same printed work; also "The London Journal of Arts and Sciences," volume 4, for 1834; also "The Repertory of Patent Inventions," London, 1834, and the same work for 1843; also "Text Book of Chemical Philosophy," Philadelphia, 1829, by Jacob Green; also "Reese's Encyclopedia," article "gypsum," also article "Mica," also "asbestos;" also "Dr. Mitchell's Elements of Chemistry," published in New York, article "gypsum;" also "Beek's Chemistry," article "gypsum;" also 22d volume of "Silliman's Journal;" also "Journal of Franklin Institute," volume 7, new series; also "Ure's Dictionary of Arts;" and the several printed publications, or works, and authorities referred to in the several above mentioned printed publications or works.

And the said defendants, Charles J. Gayler and Leonard Brown, will further insist upon, and give in evidence upon the trial of this cause as aforesaid, a certified and authenticated copy of the following patents, and the specifications thereunto appertaining, issued to the following named persons, to wit:

Patent to John Scott, dated in the month of July, 1835.

Patent to the defendant, Charles J. Gayler, dated in the month of April, 1833, and which was afterwards surrendered by the said Charles J. Gayler, and re-issued to him in the month of April, 1835.

Patent to Jesse Delano, dated March 7, 1826, which was afterwards surrendered by the said Jesse Delano, and re-issued to him in the month of August, 1834.

Patent to the said Daniel Fitzgerald, for safe and desk, dated in the month of August, 1837.

Patent to Benjamin Sherwood, and a certified copy from the records of the assignment thereof to Enos Wilder.

Patent issued in England in the month of February, 1834, to William Marr, of London. Certified copies of the several specifications filed in the Patent office at Washington, by Daniel Fitzgerald, or by Enos Wilder, the assignee of Daniel Fitzgerald, or by T. P. Jones, the attorney of Enos Wilder.

Also certified copies of the correspondence of each of them, the said Daniel Fitzgerald, Enos Wilder, and Benjamin Sherwood, with the Commissioner and examiners of patents, and with the clerks in the Patent office in Washington, and of the said Commissioner, examiner, and clerks, with each of them, the said Daniel Fitzgerald, Enos Wilder, and Benjamin Sheerwood.

And the said defendant, Charles J. Gayler, will further insist upon, and give in evidence upon the trial of this cause as aforesaid, the following documentary evidence, and printed papers, advertisements, and handbills, viz:

Printed handbills of A. S. Marvin, dated New York, Sept. 13, 1843.

The following newspapers, printed in the city of New York, and in the city of Boston, containing advertisements that the Phœnix safe was offered for sale by Daniel Fitzgerald, patentee, and that the same safe, under the name of Wilder's Patent Salamander Safe, was offered for sale by Silas C. Herring, as agent for Enos Wilder, and also as agent for the plaintiff in this suit; which advertisements are from the year 1836 to the present time, viz: The Morning Courier and New York Enquirer, the New York Gazette, the Journal of Commerce, the New York Express, the Commercial Advertiser, the Evening Post, the Sun, the New York Herald, and the Tribune, all of them being public newspapers, published in the city of New York. The Boston Post and the Boston Courier, being public newspapers, published in the city of Boston; a printed pamphlet, headed "Wilder's Patent Salamander Safe—Imperishability Secured," with the name "Silas C. Herring, 139 Water, corner of Depeyster street, New York;" printer's name, G. F. Nesbitt, stationer and printer, corner of Wall and Water streets, New York.

Each and every of the affidavits read in support of, and in opposition to, the motion for an injunction made in this court in the suit commenced by bill of complaint, filed by Enos Wilder against Charles J. Gayler and others, defendants, and the joint and separate answers of the said defendants, filed in said suit, and also the several letters, handbills, drawings, and papers annexed to the affidavits, or either of them.

And the said defendants, Charles J. Gayler and Leonard Brown, will further insist upon, and give in evidence upon the trial of this cause as aforesaid, that the said pretended invention and discovery and application of the said Daniel Fitzgerald was not of a new and useful discovery, or a new and useful improvement or application of the said Daniel Fitzgerald solely, but of the said Daniel Fitzgerald and Benjamin Sherwood jointly.

And please further to take notice, that the following persons will be examined as witnesses upon the trial of this cause on the part of the defendants, to prove the several facts stated and set forth in this notice, in addition to the printed publications or works, public newspapers and handbills, or pamplets, and the documentary evidence above mentioned, to wit:

Joseph Masetti,
Thomas W. Donovan,
John L. Brown,
John Stevens,
John B. Stearnes,
Nathaniel Hodgson,
——— Rhoades,
John Bruce,
John Ferguson,
John Hendrickson,
Michael Conroy,
Jesse Delano,
William Delano,
Alman Roff,
Frederick Geisler,
James Robertson,
John Hodkins,
Crandel Rich,
Asor S. Marvin,
Charles Davis,
George Ball,
Norman Atwater,
Elisha M. Atwater,
Robert Atwater,
Rufus Chase,
Edward L. James,
Lucius S. Comstock,
William Frost,

John Conner,
Frederick A. Gay,
Silas C. Herring,
Daniel Fitzgerald,
Andrew Latimer,
James Salmon,
George Coutant,
John Mahegan,
David Daniel,
James R. Chelton,
James J. Mapes,
Leonard W. Gale,
Jonas Humble, jr.,
Benjamin Sherwood,
Elisha Fitzgerald.

All of the above witnesses reside in the city and State of New York.

George Bruorton,
William Franklin,
Charles Franklin,
George Birbeck,
——— Birbeck,
——— Hibbard,

All of these witnesses reside in the city of Brooklyn, Kings county, and State of New York.

William Leavenworth, of or near Long Branch, in the State of New Jersey.

George W. Cross,
Charles Keine,
Hugh Scott,
James Barnes,
Jacob Wackara,
William Black,
David Evans.

Of the city of Philadelphia, in the State of Pennsylvania.

Constable, Strickler, of the firm of Constable and Strickler, Pittsburg, State of Pennsylvania.

Attwood, Jones, of the firm of Attwood, Jones & Co., and of the firm of Jones, Attwood & Co., Pittsburg, Pennsylvania; Edward Duffy, Pittsburg, State of Pennsylvania; T. Barrett, Wilmington, State of Delaware; John Scott, Baltimore, State of Maryland.

J. F. Thayer,
Oliver Edwards,
——— Adams,
——— Bisbee,
——— Holman,
——— Pond,
Stephen A. Pierce.

All of these witnesses reside in the city of Boston, State of Massachusetts.

Henry L. Ellsworth, the late Commissioner of Patents, residence believed to [be] in Washington, District of Columbia.

T. P. Jones, Edmund Burk, Washington, District of Columbia.

William Bonner, Davoch, Buffalo, State of New York.

Yours, &c.,

J. W. C. LEVERIDGE,
Attorney for defendants.

NEW YORK, *March* 6, 1846.

To J. B. STAPLES, esqr.,
Attorney for plaintiff.

And a further notice was served on the 15th of April, 1846, of which the following is a copy:

Please to take notice that, under the plea of general issue filed in this cause, a copy of which has been heretofore served upon you, with a notice, pursuant to the act of Congress of the United States in such case

made and provided, the defendants, Charles J. Gayler and Leonard Brown, will give in evidence upon the trial of this cause, and examine as witnesses upon the trial, to prove the several facts stated and set forth in their said notice, heretofore served upon you with said plea, in addition to the witnesses named in said notice; and also in addition to the printed publications or works, public newspapers, and handbills, and pamphlets, and documentary evidence mentioned in said notice heretofore served upon you, the following named witnesses, viz., John W. James, William Spencer, Hugh Murray, John T. Doyle, Michael McCormick, Eugene Casserly, Michael Murphy. All of the above named witnesses reside in the city and State of New York.

Hiram Burrows, of Newfoundland, and David F. Baker, of Shrewsbury, in the State of New Jersey.

Also the following printed publications, of which you have heretofore had notice, under the respective titles or articles "Alabaster," "Talc," "Quartz," and in addition thereto the different encyclopedias and works on chemistry. Also, that the defendants, Charles J. Gayler and Leonard Brown, will produce in court, for the inspection thereof, and of the several witnesses and the jury, two iron chests or safes, made by Elisha Fitzgerald and Daniel Fitzgerald, or by Fitzgerald and Sherman. Also an iron chest or safe, made by J. L. Brown & Co., filled with composition. Also an iron chest or safe, made by John Bruce and Nathaniel Hodgson, and also an iron chest or safe made by Benjamin Sherwood.

Yours, &c., J. W. C. LEVERIDGE.

NEW YORK, *April* 13, 1846.

And a further notice was served on the 3d day of June, 1847, of which the following is a copy:

SIR: You will please take notice that, on the trial of the above cause, under the general issue pleaded in said cause, the defendant will insist upon and give in evidence, and prove by the following named persons, in addition to the persons named in the former notice, that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, and that it contains more than is necessary to produce the described effect; and that concealment on the one part, and the addition on the other, was made for the purpose of deceiving the public; and that Daniel Fitzgerald, the patentee, was not the original and first inventor or discoverer of the thing patented, or of a substantial or material part thereof; and that the same thing had been described in the several printed works and publications mentioned and referred to in the notices heretofore served upon you, anterior to the supposed discovery thereof [by] the said Daniel Fitzgerald as such patentee; and that the same had been in public use and on sale, with the consent and allowance of the said patentee, before his application for a patent; and that he had surreptitiously and unjustly obtained the patent for that which was in fact invented and discovered by another; and generally to prove all other matters mentioned, stated, and referred to in said notice, viz., Henry C. Spicer, Joseph M. Marsh, Joseph Bouch-

eaud, all of the city of New York; and William H. Whitely, of the city of Boston, State of Massachusetts.

Dated New York, June 1, 1847.

Yours, &c.,

J. W. C. LEVERIDGE.

And a further notice was served on the 16th day of September, 1847, of which the following is a copy:

SIR: To maintain the general issue in this cause, the defendants will produce in evidence to prove that a fire proof safe was constructed, known, and used, substantially the same, in all respects, as that described in the patent specification declared on in this cause, in the city of New York, in the year 1832 and 1833; and before, by James Conner and John Conner, type founders; the former being county clerk of the county of New York, and the latter being his brother, and both named in the city directory; and the testimony will be corroborated by G. F. Mott, 45 Gold street, and William Hagar, Gold street, type founder, and William R. Cook, residing at Greenfield, Connecticut.

Yours, &c., J. W. C. LEVERIDGE.

N. YORK, Sept. 15, 1847.

And hereupon the process thereof is continued between the parties aforesaid, of the plea aforesaid, in this same court, before the judges thereof, until the third Monday in October, in the year of our Lord eighteen hundred and forty-seven, at the City Hall, in the city of New York; and the same day is given to the parties aforesaid at the same place.

Therefore, the issue above joined is ordered to be tried by the said circuit court of the United States, to be tried at a circuit court appointed to be held at the City Hall, of the city of New York, in and for the southern district of New York aforesaid, on the third Monday in October, in the year 1847. At which day and place last mentioned, before the honorable Samuel Nelson, circuit judge of the United States in and for the southern district of New York, in the second circuit, according to the form of the statute in such case made and provided, come as well the above named plaintiff as the above named defendants, by their respective attorneys aforesaid. And the jurors of the jury summoned to try the said issue, being called, also come; who, to speak the truth of the matters aforesaid, being chosen, tried, and sworn, say upon their oath that the said defendants are guilty of the premises above laid to their charge in manner and form as the said plaintiff hath above thereof complained against them, and they assess the damages of the plaintiff, by reason of the premises, over and above his costs and charges by him about his suit in this behalf expended, to eighteen hundred dollars, and for those costs and charges to six cents.

Therefore, it is considered that the plaintiff, Benjamin G. Wilder, do recover against the defendants, Charles J. Gayler and Leonard Brown, his said damages, costs, and charges by the jurors aforesaid in form aforesaid assessed; and also three hundred and fifty-one dollars and

thirty cents for his said costs and charges by the court now here adjudged to the said plaintiff of increase, and with his assent; which said damages, costs, and charges in the whole amount to two thousand one hundred and fifty-one dollars and thirty-six cents. And the said Charles J. Gayler and Leonard Brown, defendants, in mercy, &c.

Judgment signed this 15th day of November, eighteen hundred and forty-seven. D. L. GARDINER, *Depvty Clerk*.

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CIRCUIT COURT OF THE UNITED STATES,
Southern district of New York:

CHARLES J. GAYLER and Leonard Brown, ads.
BENJAMIN G. WILDER, assignee of Enos Wilder, deceased,

I consent that George Sullivan, esq., be substituted as the attorney for the defendants in the above entitled suit, and that a rule for substitution to that effect be entered.

J. W. C. LEVERIDGE,
Attorney for defendants.

NEW YORK, *November* 16, 1847.

SUPREME COURT OF THE UNITED STATES.

From the circuit court, United States, for southern district of New York.

BENJAMIN G. WILDER
vs.
CHARLES J. GAYLER
and LEONARD BROWN.

Be it remembered that, on the trial of the aforesaid issue, the plaintiff, to maintain the same, after having read said patent in evidence as set forth in the declaration, read the following conveyance and agreement, which was duly recorded, and a copy of which was, at the date of said patent, endorsed on the same, viz:

"Whereas I, Daniel Fitzgerald, of the city, county, and State of New York, have invented certain improvements in safes, which invention I call the Salamander safe, for which I am about to make application for letters patent of the United States; and whereas E. Wilder, of New York aforesaid, has agreed to purchase from me all right and title and interest which I have, or may have, in and to the said invention, in consequence of the grant of letters patent therefor, and has paid to me, the said Fitzgerald, the sum of five thousand dollars, the *the* receipt of which is hereby acknowledged; now, this indenture witnesseth, that for and in consideration of the said sum to me paid, I have assigned and transferred, and do hereby assign and transfer, to E. Wilder aforesaid, the full and exclusive right to all the improvements made by me,

as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor; and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder, as the assignee of my whole right and title thereto, for the sole use and behoof of the said E. Wilder and his legal representatives.

In testimony whereof I have hereunto set my hand and affixed my seal, this eleventh day of April, 1839.

(Signed) DANIEL FITZGERALD. [L. S.]

Received and recorded June 1, 1839.

Witness—

OWEN G. WARREN,
CHARLES H. FORBES."

And thereupon the defendants insisted that said instrument did not convey the legal title of said patent to the said Enos Wilder, and that, upon such conveyance, he could not have brought a suit on the same; but said court decided that said instrument operated to convey the interest in said patent to said Enos Wilder, so that, during his life, he could have maintained an action at law on the same; to which opinion of said court the counsel for the defendants then and there excepted.

1st exception.

And the plaintiff then read the conveyance from said Enos Wilder to him as stated in his said declaration, which he insisted made out a right in him to sustain his aforesaid action; but the defendants to shew that, after the date of the conveyance to the plaintiff, and before he commenced this action, he made, executed, and delivered, to Silas C. Herring, esq., the following agreement and conveyance, namely:

"Benjamin G. Wilder agrees with Silas C. Herring to grant to him the sole and exclusive right to make the safe, called the Salamander safe, according to the terms and upon the plan pointed out and described in the patent and specification of Daniel Fitzgerald, which patent is dated June 1, 1843, and was assigned to Enos Wilder, and by him to Benjamin G. Wilder, who now owns the same; and this license is to be for the city, county, and State of New York; and said Herring is to have and enjoy the full and exclusive right to make and vend said safes in the city, county, and State of New York, and nowhere else; the said Herring is to have the same for the residue of the unexpired term of said patent, with all the improvements which may be made in the manufacture of said safes which said B. G. Wilder may have a right to use during said term; and said Herring agrees that said Wilder may use all the improvements which he may make, or have a right to use, during said term. In consideration whereof said Herring agrees with said Benjamin G. Wilder to pay to him, for the use of the right aforesaid, one cent a pound for each and every pound said safes may weigh when finished and sold; which sum is to be paid monthly so long as said patent remains in full force, and until the same has been set aside by the highest court of the United States to which the same may be carried; but said Herring agrees to pay the one cent a pound for the

space of two years, at all events, and whether said patent shall be declared good or not. If sustained, then said Herring is to pay as aforesaid for the full term as aforesaid. All the safes so made and sold by said Herring are to have said Wilder's patent marked thereon, the same as heretofore, in a plate, or cast in letters, "Wilder's patent safe." Said Herring agrees to keep an accurate account of all the safes by him made, or caused to be made, under said contract and patent, with the weight of each when sold, and the names of the persons to whom sold, and their places of abode, and to render said account monthly, if so often called on for it, and to pay accordingly. Said Herring is to manufacture all the safes he may sell, or offer to sell, under and according to said patent, with such improvements as he may have a right to use, and be marked as above with the words, in large legible letters, "Wilder's patent safe." Said Wilder reserves to himself the right to manufacture, in this city and State of New York, or elsewhere, safes to sell out of this State and city; but if sold within this State or city, then said Wilder is to pay said Herring one cent a pound on each safe so made and sold within this city or State. Said Wilder is not himself to set up or establish, nor authorize any one else to set up and establish, any manufactory or works for making Salamander safes, or safes similar to said Salamander safes, at any place within fifty miles of this city. Said Herring is to make all safes like Wilder's, and not vary in any substantial part therefrom, with such improvements as may be added.

"In presence of—

S. P. STAPLES,

Witness to both signatures.

"NEW YORK, *January 6th*, 1844.

"If said patent should not be decided to be good till the end of three years, then for the time over the two years, till decided good, said Herring pays nothing. It is further understood and agreed, that all safes made by said Herring, or in the making of which or the selling thereof he shall in any way be directly or indirectly concerned, consisting of a double case or box with the intermediate space filled with plaster or any non-conducting substance, shall be considered within this agreement, and be paid accordingly. "B. G. WILDER,

SILAS C. HERRING."

"(Received and recorded 30th January, 1844.)"

2d exception.

And thereupon the defendants insisted that the plaintiff had parted with all his interest in said patent by virtue of said agreement, so that he could not sustain his aforesaid action. But said court decided that the plaintiff had not, in and by said agreement, so far parted with his interest in said patent as to deprive him of the right to sustain his aforesaid action; to which opinion of said court the defendants did then and there except.

3d exception.

And the defendants then and there objected, that the invention and

improvement, set forth and claimed in said patent as the invention of the patentee, was not the subject of a patent; that it was the mere application of an old well known material to a new purpose, which they insisted could not be the subject of a patent. But said court overruled said objection, and instructed the jury as herein set forth; to which, as well as to the said instructions to said jury, the defendants excepted.

And the plaintiff, to maintain his aforesaid issue, called sundry witnesses to prove, and claimed that he had proved, that he made the discovery which was the foundation of his invention and improvement as early as some time in the year 1830; that he made experiments in various ways, to test the utility of his discovery and improvement, at different times, in the different years from 1830 to 1836, when he applied for his patent; and that he pursued with due diligence that application until he obtained his aforesaid patent; and that the delay which had arisen in obtaining said patent was not caused by the fault or negligence of the patentee, or his assignee, Enos Wilder, nor any one else, but arose from the burning of the Patent office, and other causes not under the control of the applicants for the patent; and that the defendants had infringed said patent, as set forth in said declaration.

And the defendants introduced evidence to prove, and claimed that they had proved, that said Daniel Fitzgerald was not the first and original inventor of what he claimed in said patent as his improvement. Among other witnesses, James Conner testified, that, between 1829 and 1832, he was engaged in business as a stereotype founder, and, knowing that plaster of paris was a non-conductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of paris—the same, substantially, as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in his counting-room while he used it, and known to the persons working in the foundry.

This testimony was confirmed by his brother, John Conner, except [that] he fixes the time of constructing the safe to the years 1831 or 1832. But one safe was made by Conner, and since it passed out of his hands he has used others of a different construction.

The defendants also claimed that, if said Daniel Fitzgerald was the first and original inventor of said improvement, as he claimed, yet that he had made said iron safes, and sold them, under such circumstances as that he had thereby abandoned the same, and suffered the same to go into public use in such manner as to lose all right to said invention and improvement, if any he ever had.

And the court thereupon instructed the jury that, if they found that Daniel Fitzgerald, the patentee, was the first and original inventor of the said improvement claimed in said patent, and that the use of plaster of paris, in combination with and in the construction of an iron safe, is new and useful, as in the specification of said patent is set forth and claimed, then they would find that the patent was valid, and protected

the invention and improvement as claimed, unless the plaintiff, or those under whom he claimed, had abandoned said improvement to the public, and suffered the same to go into public use before the application for said patent, of which facts the jurors were the judges.

And said court further instructed said jury, that if they found that the use made by James Conner of plaster of paris was confined to a single iron chest, made for his own private use after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid; but if the jury found that said James Conner made his said safe, as claimed, and tested it by experiments before Fitzgerald's invention and improvement, and before he tested the same, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent.

"The court further charged, that, independently of these considerations, there was another view of the case, as it respected the Conner safe: that it was a question whether the use of it by him had been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and which had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement

4th exception.

And said court, in summing up said case to said jury, further instructed them, that if they found that Daniel Fitzgerald was the first and original inventor of said improvement, as set forth in said patent, and had not abandoned or dedicated the same to the public, but had, with reasonable diligence, pursued his invention till he had perfected the same, and used due diligence in applying for, and in pursuing his application for a patent, until he obtained the same, and if they found the defendants had made and sold safes, as charged in the plaintiff's declaration, then they would find their verdict for the plaintiff for such actual damages as they judged just and reasonable; but if they found otherwise, then they would find for the defendants. To each and all of these instructions given to the jury, the counsel for the defendants excepted.

And forasmuch as the facts aforesaid, and the decisions of the court thereon, do not appear of record, the defendants pray that this their bill of exceptions may be allowed.

~~Filed 23d February, 1848.~~ S. NELSON. [SEAL.]

Assignment of errors.

CHARLES J. GAYLER and LEONARD BROWN, plaintiffs in error, vs. BENJAMIN G. WILDER, defendant in error. } No. 210.

United States Supreme Court. December term, 1847.

Afterwards came Charles J. Gayler and Leonard Brown, plaintiffs in